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|--|-------------|----------------------|---------------------|------------------|
| 10/038,004   | 01/02/2002  | Daniel R. Baum       | Shutterfly 04C001   | 8059             |
| 31688  | 7590        | 08/12/2005           | EXAMINER            |                  |
| TRAN & ASSOCIATES<br>6768 MEADOW VISTA CT.<br>SAN JOSE, CA 95135 |             |                      | GARG, YOGESH C      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3625                |                  |

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/038,004

Applicant(s)

BAUM, DANIEL R.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

4A

### **DETAILED ACTION**

1. In view of the Supplemental Appeal Brief filed on 10/15/2004 PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 and 13-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lockhardt et al. (US Publication 2002/0103697), hereinafter referred to as Lockhardt.

Regarding claim 1, Lockhardt teaches a computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

Receiving a single card order specifying a plurality of recipients and, for each specified recipient, a set of one or more images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence (see at least page 2, paragraphs 0021-0023, teach specifying contents to be included in a card [such as postcard, folding-outcard, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11] for a recipient. The contents to be included in the card include images which, one or more, are directly uploaded by a user associated with that recipient [see paragraphs 0050-0062]. Lockhardt also teaches that the order received specifying the contents for the said card can be addressed to a plurality of recipients [see at least paragraph 0086 " ....and from which the user may select one or more desired addresses (step 220.....) and paragraph 0088, ".....For example, a single card design may be used for a variety of recipients.....]. Selection of one or more addresses corresponds to a plurality of recipients. Lockhardt also teaches

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completing this single card order in a single transaction [see paragraph 0095 which teaches that after selecting recipient address [or addresses, as indicated above] the user's account, if it has a positive balance, is debited in a single transaction sequence.);

for each of the plurality of recipients specified in the received card order, printing at least one card having at least one user-uploaded image from the recipient's image set (see at least paragraph 0100); and

distributing the printed cards having the recipients' user-uploaded images to their respective associated recipients (see at least paragraph 0100 which discloses that after printing the cards they are mailed to their respective recipient addresses).

Regarding claim 2, Lockhardt discloses that the card is one or more of a greeting card, a post card, and a playing card (see at least page 2, paragraphs 0021-0023, teach specifying contents to be included in a card [such as postcard, folding-outcard, or the like-which can include greetings cards, as suggested in paragraphs 6 and 11]).

Regarding claim 3, Lockhardt teaches that the images could differ from first recipient to a second recipient (see at least paragraph 0103, page 7 which discloses that the card content includes both fixed and variable data, wherein the variable data includes graphic data, that is images as they are specific to an individual recipient's card).

Regarding claim 4, Lockhardt discloses that print parameters of a first recipient's cards differ from printing parameters of a second recipient's card and wherein the print parameters include one or more of print size, number of copies, print finish, and/or

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textual message for the printed card(see at least paragraphs 0103-0110, page 7 which discloses that the card content includes both fixed and variable data, wherein the variable data includes graphic data, that is images as they are specific to an individual recipient's card, destination address and text and all this data correspond to print parameters).

Regarding claim 5, Lockhardt teaches that the images are uploaded by a user from a digital camera (see at least paragraphs 0028 and 0078 which teach uploading images from a video or digital camera).

Regarding claim 6, Lockhardt teaches that images are uploaded by a user to a printing service (see at least paragraph 0023. It teaches uploading the images to a printing facilities 114. Note: The claim does not specify the details of uploading the images from the user. As known to one of an ordinary skilled in he art uploading of data means transfer of digital files from one computerized device to another device via a modem/network and Lockhardt teaches the same in disclosing that the user's images are uploaded to the printing facilities from mail service computer 110 and mail service computer 110 received the images from the user's computing device.

Regarding claim 7, Lockhardt teaches that receiving, printing and distributing is dispersed among two or more different entities ( see at least paragraphs 0021-0024 which teach receiving is done by mail service computer 110 and the printing is done by another entity "114" and distribution is done by third entity "120").

Regarding claim 8, Lockhardt suggests that receiving, printing and distributing can be done by a single entity (see paragraph 0041, "....the printers and mail service computer may be located within the same general area....." which implies that receiving, printing and after printing mailing/distributing can be organized from one place.)

Regarding claim 9, Lockhardt teaches that receiving a card order is performed by an enterprise providing a web front-end (see at least paragraphs 0038-0039, which discloses that the mail service computer 110 provides a suitable website.....).

Regarding claim 10, Lockhardt teaches that the claim one further comprising, prior to printing, dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (see at least paragraphs 0086-0088. A single card can be sent to a variety of recipients with different addresses and that implies that the single card order is split into different sub-cards to be printed and mailed to different addresses).

Regarding claim 13, Lockhardt teaches that the card order further comprises charging to one or more of a credit card, a debit card.....( see at least paragraph 0095).

Regarding claims 14-21, their limitations are closely parallel to the limitations of claims 1-10 and 13, as analyzed above and are therefore analyzed and rejected on the same basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhardt and further in view of Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lockhardt and further in view of Hartman et al. (US Patent 5,960,411), hereinafter referred to as Hartman.

Regarding claims 11 and 12, Lockhardt does not disclose that single transaction sequence is terminated by an order icon/a click of a card-order button. However, in the



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same filed of endeavor of online ordering, Hartman discloses that the single transaction sequence is terminated by a click of an order icon or a "card order" button. (see at least col.2, lines 50-57, "*An embodiment of the present invention provides a method and system for ordering an item from a client system.....The client system displays information that identifies the item and displays an indication of an action (e.g., a **single action such as clicking a mouse button**) that a purchaser is to perform to order the identified item.....*". Note: In Hartman, **a single action such as clicking a mouse button** ' corresponds to a click of "card order" button or an order icon as claimed.). In view of Hartman, it would have been obvious to a person of an ordinary skill in the art at the time of the applicant's invention to have modified Lockhart as applied to claim 1 to incorporate the Hartman's teachings of terminating the single transaction sequence by a click of an order icon or a "card order" button because such ordering system reduces the number of purchaser interactions needed to place an order and reduces the amount of sensitive information that is transmitted between a client system and server system, as explicitly taught in Hartman (see at least col.3, lines 30-37).

### ***Response to Arguments***

5. The applicant has argued against Lockhardt reference in the Supplemental Appeal Brief filed on 10/15/2004 ( see pages 5-6) that Lockhardt shows uploading of images but points away from the claimed element of Receiving a single card order specifying a plurality of recipients and, for each specified recipient , a set of one or more

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images directly uploaded by a user associated with that recipient, wherein the single card order is completed in a single transaction sequence. The examiner has considered the applicant's arguments fully but are not persuasive as analyzed above in rejecting claim 1 under 35 USC 102 (e).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
August 8, 2005